

REMARKS

Reconsideration of this application is respectfully requested. Claim 37 has been amended. Support for this amendment is found, for example, at page 6, lines 5 - 20. No new matter has been added.

The amended claims are directed to an *in vitro* assay for detecting HIV-1 reverse transcriptase (RT) activity. Applicant has amended claim 37 to omit the phrase "endogenous." This term was included in the original claim to indicate that the RT activity was native to the HIV-1 virus, and not to distinguish the assay from an "exogenous" assay. As the Examiner correctly points out, an "endogenous" RT assay is an assay that utilizes viral RNA as a template for reverse transcription, and an "exogenous" assay is an assay that utilizes a synthetic template, such as, for example, polyA-oligo dT as a template for reverse transcription. See, Office Action at 2.

Priority under 35 U.S.C. § 120

The Examiner alleges that U.S. Serial No. 06/558,109, filed December 5, 1983, and U.S. Serial No. 06/706,562, filed February 28, 1985, fail to provide adequate support for the claimed invention, and therefore cannot be relied upon by the Applicant. Without acquiescing, Applicant amends claim 37 to omit the phrase "endogenous," and indicates that the reaction includes oligo dT. Amended claim 37 is supported by U.S. Serial No. 06/558,109 at page 5, lines 1-21, and page 5 line 27 to page 6, line 14, for example, and by U.S. Serial No. 06/706,562 at page 6, lines 5- 19, for example. Therefore, this application should be afforded its earliest effective filing date, which is December 5, 1983.

Rejections under 35 U.S.C. § 102(b)

Claims 37-39 stand rejected under 35 U.S.C. § 102(b) as anticipated by Rey *et al.* (1984). This ground for rejection is respectfully traversed and reconsideration is respectfully requested for the following reason.

In order for a printed publication to qualify as prior art under § 102(b), the publication must be published more than one year prior to the date of application for patent in the United States. 35 U.S.C. § 102(b). Applicant is entitled to claim priority under 35 U.S.C. § 120 in order to antedate potential 102(b) art.

As discussed above, amended claim 37 is entitled to an effective filing date of December 5, 1983. Since Rey *et al.* is dated May 31, 1984, it is not valid 102(b) art. Applicant notes that even if Applicant was not entitled to claim priority to the December 5, 1983 filing, Rey *et al.* would still not qualify as prior art because Applicant is also entitled to claim priority under 35 U.S.C. § 120 to U.S. Serial No. 06/706,562, filed February 28, 1985, which also disqualifies Rey *et al.* as prior art. Thus, Applicant respectfully requests the withdrawal of the anticipation rejection over claims 37-39.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 37-39 were rejected as indefinite for allegedly referring to an “endogenous” RT assay, yet failing to provide the requisite steps required to perform such an assay. The amendment to claim 37 omits the term “endogenous”, and adds the phrase “wherein the reaction mixture includes oligo dT.” Thus, this rejection may be withdrawn.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 37-39 were rejected as allegedly failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph. The Examiner alleges that the claims are directed to an endogenous RT assay, and only exogenous assays are described in the specification. Without acquiescing, Applicant amends claim 37 to omit the phrase "endogenous," and indicates that oligo dT is used. Thus, this rejection may also be withdrawn.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this paper and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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